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In re Application of : DECISION ON
CHEN, Tao et al. :
US Application No.: 09/674,191 :
PCT Application No.: PCT/US99/09076 : PETITION
Int. Filing Date: 27 April 1999 :
Priority Date: 28 April 1998 : UNDER
Attorney's File Reference: 016303-007010US : 37 CFR 1.47(a)
For: POLYANIONIC POLYMERS WHICH
ENHANCE FUSOGENICITY

This decision is in response to applicants' "PETITION FOR FILING PATENT APPLICATION UNDER 37 CFR 1.47(a) . . .", filed 18 June 2001, which requests acceptance of the application without the signature of co-inventor Jung Soo Kim (Kim). The \$130.00 petition fee has been paid.

BACKGROUND

On 27 April 1999, applicants filed international application number PCT/US99/09076, which claimed priority to a prior US application filed on 28 April 1998. On 23 November 1999, applicants filed a Demand for international preliminary examination, in which the United States was elected. Accordingly, the thirty-month period for paying the basic national fee in the United States of America expired at midnight on 30 October 2000 since 28 October 2000 was a Saturday.

On 26 October 2000, applicants filed a transmittal letter for entry into the national stage in the United States of America, which was accompanied by, *inter alia*, the basic national fee. No oath or declaration of the inventors was included.

On 18 December 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements which indicated, *inter alia*, that an oath or declaration of inventorship and the requisite surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than 30 months from the priority date must be furnished within one month of the mailing date of the notification. The notification also

stated that failure to properly respond to the notification would result in abandonment but that extensions of time were available under 37 CFR 1.136(a).

On 18 June 2001, the applicants filed, inter alia, the following papers:

- 1) a petition under 37 CFR 1.47(a) giving the last known address of nonsigning inventor Kim and the required \$130.00 petition fee;
- 2) a declaration signed by Jeanette McDougall (McDougall), employee of assignee Inex Pharmaceuticals Corporation, detailing the steps that she took to locate missing inventor Kim and concluding that missing inventor Kim could not be located;
- 3) copies of documentary evidence consisting of email correspondence between McDougall and co-inventors Pieter Cullis (Cullis) and David Tirrell (Tirrell) and between McDougall and Myungsoo Kim who is an employee of the Korean Institute of Science and Technology;
- 4) a declaration and power of attorney including the names, signatures, and countries of citizenship of co-inventors Toa Chen (Chen), Yuehua He (He), Cullis, Thomas Madden (Madden), Peter Scherrer (Scherrer), Tirrell, and Phalgun Joshi (Joshi) and including the name of co-inventor Kim but failing to provide the country of residence or signature of Kim;
- 5) a \$65.00 surcharge for a late declaration required under 37 CFR 1.492(e); and
- 6) a petition for a 5-month extension of time along with the requisite fee of \$945.00.

DISCUSSION

37 CFR 1.47(a) states:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

MPEP 409.03(a) entitled "At Least One Joint Inventor Available" states:

37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, requires all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application."

In addition to other requirements of law (35 U.S.C. 111(a) and 115), an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a) must meet the following requirements:

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

(B) The application must be accompanied by proof that the nonsigning inventor (1) cannot be found or reached after diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

(C) The last known address of the nonsigning joint inventor must be stated. See MPEP § 409.03(e).

The declaration filed 18 June 2001 fails to provide the country of citizenship of nonsigning co-inventor Kim and thus fails to comply with 35 USC 115 and 37 CFR 1.147.

There is also some question as to whether or not the declaration filed 18 June 2001 was properly executed as required under 37 CFR 1.497. The declaration consists of 5 pages in total. The first page has no page number thereon. The second page is numbered "2 of 3". The third, fourth, and fifth pages are each numbered "3 of 3". The first three pages comprise a complete declaration and the third page thereof is signed by Chen, Cullis, Madden, Scherrer, and Joshi. The fourth page, which is signed by Madden, and Tirrell, appears to include only the third of three pages of a declaration. Similarly, the fifth page, which is signed by He and Madden, appears to include only the third of three pages of a declaration. Accordingly, it is unclear whether or not Tirrell and He each had a complete copy of the declaration at the time they executed the declaration.

Applicants are required to submit a properly executed oath or declaration.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response to this decision will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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